Remarks

The office action mailed February 28, 2006 has been carefully reviewed and these remarks are responsive thereto. Applicants herein amend claims 14, 16, 18-23, 25, and 26, and cancel claims 15 and 24 without prejudice or disclaimer. No new claims have been added, and no new matter has been introduced. Claims 14, 16-23, 25, and 26 are thus now pending in this application. Reconsideration and allowance of the instant application are respectfully requested.

Objections to the Specification

The abstract of the disclosure was objected to because it was not submitted on a separate page and because it contained claim language. The disclosure was also objected to based on informalities relating to section headers. Applicants have amended the specification as requested to include section headers pursuant to 37 C.F.R. § 1.77(b). Due to the numerous amendments made to the specification, Applicants submit the attached substitute specification in accordance with 37 CFR 1.125(b), and also submit a version showing all the changes made relative to the prior version of the specification of record in accordance with 37 CFR 1.125(c). No new matter has been added.

Rejections under 35 U.S.C. § 112

Claims 14 and 22 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite based on the recitation of the phrase "and/or" in these claims. Applicants have amended claims 14 and 22 as requested by the office action, and have similarly amended claim 23, to replace the "and/or" phrase and to better clarify the claims. Accordingly, Applicants respectfully request the withdrawal of the pending rejections under 35 U.S.C. § 112.

Rejections under 35 U.S.C. § 102

Claims 14, 17-23, and 26 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,889,198 to Kawan (*Kawan*). Applicants respectfully traverse. Independent claim 14 has been amended to incorporate the subject matter of cancelled claim 15. Independent claim 22 has been similarly amended to incorporate the subject matter of cancelled claim 24.

Since claims 15 and 24 do not stand rejected under § 102, Applicants submit that the pending rejections under 35 U.S.C. § 102 are therefore moot. Amended independent claims 14 and 22, as well as their respective dependent claims 16-21, 23, 25, and 26, are discussed below in regards to the rejections under 35 U.S.C. § 103.

Rejections under 35 U.S.C. § 103

Claims 15, 16, 24, and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kawan* in view of U.S. Patent No. 6,293,865 to Kelly *et al.* (*Kelly*). Applicants respectfully traverse. As discussed above, claims 15 and 24 have been cancelled without prejudice or disclaimer. Independent claims 14 and 22 have been amended to incorporate the subject matter of cancelled claims 15 and 24, respectively. Applicants believe that claims 14 and 22 contained patentable subject matter even before the present amendments, and are amending these claims simply to expedite prosecution and further distinguish from the cited references.

Amended claim 14 recites, in part, "the calculating means comprising means for formatting data output from the registers in a uniform way, the display means being configured to display information corresponding to said formatted data in a uniform way." The office action states on page 4 that *Kawan* discloses a calculating means and a display means. However, unlike the invention as recited in claim 4, *Kawan* does not disclose formatting or displaying the data in a uniform way. The office action alleges that these features are disclosed at *Kawan*, col. 5, lines 35-38 ("[t]he terminal 2 can then display the point balance..."). However, merely displaying a point balance is different than displaying data for "a plurality of merchant loyalty programs" formatted and displayed "in a uniform way," as recited in claim 14.

Applicants further note that the main object of *Kawan* does not relate to the formatting or displaying of smart card data at all. Rather, *Kawan's* purpose is directed toward tracking and updating smart card loyalty points, thus allowing an inexpensive implementation of a merchant loyalty program. (*Kawan*, Abstract; col. 1, line 56 to col. 2, line 10). Accordingly, *Kawan's* reference to displaying a point balance does not disclose or even suggest "the calculating means comprising means for formatting data output from the registers in a uniform way, the display means being configured to display information corresponding to said formatted data in a uniform way," as recited in claim 14.

Since *Kelly* also fails to disclose formatting and displaying smart card data for multiple merchant loyalty programs "in a uniform way," Applicants submit that claim 14 is patentable over the alleged combination of *Kawan* and *Kelly*. Claims 16-21 depend from claim 14, and are patentable over the cited references for at least the same reasons as claim 14, and further in view of the features recited therein. Amended independent claim 22 recites a similar method for processing and displaying information obtained from coded data stored in a smart card, comprising, "displaying said formatted information in a uniform way." Thus, claim 22 is patentable over the *Kawan* and *Kelly* for similar reasons to those stated above in relation to claim 14. Claims 23, 25, and 26 depend from claim 22, and are therefore patentable over the cited references for at least the same reasons

As the office action correctly states on page 5, "Kawan doesn't teach displaying that information in the form of a graded scale." The office action then relies on Figure 13 of *Kelly* as disclosing a graded scale at References 1306 and 1308.

However, there is no motivation or suggestion to combine *Kawan* with *Kelly*. The office action states that it would have been obvious to combine the references because, "[t]his would give the consumer a better impression of how many award points they have and what prizes those points could be redeemed for." This is not a motivation to combine references, however, but rather is the conclusion the examiner has apparently reached after having benefited from reading the Applicants' own disclosure, and is thus impermissible hindsight.

The Federal Circuit has repeatedly stated that the limitations of a claim in a pending application cannot be used as a blueprint to piece together prior art in hindsight, *In re Dembiczak*, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999), and that the Patent Office should *rigourously* apply the requirement that a teaching or motivation to combine prior art references needs to be provided. *Id.* (emphasis added). Thus, Applicants respectfully submit that that there is no motivation or suggestion to combine *Kawan*, which discloses method for tracking and updating smart card loyalty points, with *Kelly*, which discloses a method for determining payment for participating in a network gaming tournament.

Finally, assuming arguendo, that the *Kawan* and *Kelly* references could be combined, Applicants further point out that the features of dependent claims 16 and 25 are neither disclosed

nor suggested by either cited reference. For example, amended claim 16 recites the calculating means configured to:

> calculate for the at least one loyalty program a number of intervals corresponding to the graduated scale as a function of a predetermined unit of measurement of said program;
>
> calculate a constant size for the number of intervals; display the end points of said scale and a predetermined qualitative state associated with said scale;
>
> calculate the distance between two graduations of the scale corresponding to an interval;
>
> calculate a level of the scale based on the data from the files;

The performance of these calculations is not disclosed in the portions of *Kelly* that describe Figure 13, nor in any other portion of *Kelly* identified by the Applicants. The office action addresses this deficiency on page 6, stating, "[t]he calculations of claim 16 are seen as inherent calculations in obtaining current scale level and interval distance." Applicants respectfully disagree. There is nothing about a graduated scale that inherently requires "updating the data dynamically" on the device, as recited in claim 16. Indeed, it does not appear that the graded scale shown in Figure 13 of *Kelly* was calculated based on the current prize bucks total or the points accumulated during the current game. Accordingly, it appears that *Kelly* does not perform the above recited calculations and does not "update[e] the data dynamically," as recited in claim 16.

Applicants submit that claim 16 is patentable over the alleged combination of *Kawan* and *Kelly* for this additional reason. Amended independent claim 25 recites a similar method for processing and displaying information, wherein "the information ... is updated dynamically" based on similar calculations. Thus, claim 25 is patentable over the cited references for the same reasons.

Conclusion

Based on the foregoing, Applicants respectfully submit that the application is in condition for allowance and a Notice to that effect is earnestly solicited. Should the Examiner believe that anything further is desirable in order to place the application in even better form for allowance, the Examiner is respectfully urged to contact Applicants' undersigned representative at the below-listed number.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Dated this 28 day of Aug., 2006 By: _____

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